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Mailed
12/12/06
at

In re Application of:

KETCHUM, GARY T.

Serial No.: 09/788,274

Filed: Feb. 16, 2001

Docket: 5018

Title: LEAK POINT WETNESS SENSOR FOR
UROLOGICAL INVESTIGATIONS

:
: DECISION ON PETITION TO
: REOPEN PROSECUTION
: UNDER 37 C.F.R. 1.198 AND
: WITHDRAW FINDING OF
: ABANDONMENT UNDER 37
: C.F.R 1.181 & 1.198

This is a decision on the petition filed on Jul. 15, 2005 to reopen prosecution following the notification of abandonment on April 6, 2005. The petition is being considered under 37 CFR 1.181 and no fee is required. The petition fee paid, \$130.00, will be refunded upon request.

The petition is **dismissed**.

In his Jul. 15, 2005 petition, the applicant requested re-opening prosecution and entry of RCE with a preliminary amendment to the claims. In support of his petition, the applicant argues that on pages 4-6 of the Board decision of Dec. 10, 2004, the Board indicated that disclosed invention differs from the Ketchum patent. However, the distinguished features are not recited in claim 1 and thus cannot be relied upon for patentability. The petitioner further stated that the current assignee became aware of such Board decision after acquiring the ownership rights to this patent application. Subsequently, the current petition with RCE and a preliminary amendment were filed.

The record shows that:

- 1) On Dec. 10, 2004 the Board affirmed the examiner's rejection of claims 1-4 in this application. No claims were found allowable in the application.
- 2) On April 6, 2005 the examiner sent out a letter of abandonment for failure to take further actions within two months from the date of the Board decision.
- 3) On Jul. 15, 2005, the applicant filed the present petition, arguing that that on pages 4-6 of the decision issued by the Board of Appeals and Interferences, the Board indicates certain features disclosed but not claimed were distinguishable over the prior art references of record. Therefore, the applicant requests the examiner to re-open prosecution and enter the RCE.

Applicable Rules

M.P.E.P. § 1214.06 states in relevant part:

“The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is . . . 2 months When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve . . . :

I. NO CLAIMS STAND ALLOWED

The proceedings in an application . . . are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files.”

M.P.E.P. § 1214.07 states in relevant part:

“Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a case after decision by the Board, where no court action has been filed, are decided by the Technology Center Director, MPEP § 1002.02(c).

The Director of the USPTO also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

- (A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable. . . .”

Issue Presented

The issue presented in the present petition is whether the petition was filed timely to reopen prosecution.

Analysis

Petitioner stated that the assignee failed to realize the existence of the Board decision of Dec. 10, 2004 until an inspection of the application file after acquisition of the ownership right of the current application. The reason is insufficient to render the petition grantable under the current patent rules and regulations governing the re-opening of prosecution after the Board decision.

The petitioner also is of the opinion that the Board’s decision of Dec. 10, 2004 indicated certain subject matter distinguishable over the prior art references and therefore request the prosecution be re-opened. Petitioner appears to believe that this portion of the Board decision would justify the prosecution be re-opened.

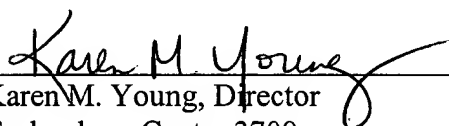
Petitioner's reasoning is also not persuasive because MPEP 1214.07 permits only if the appellant and the examiner can resolve curable defects during any further prosecution in this application. The petitioner mentioned nothing about curable defects. Moreover, by the time the present petition was filed, the application was already abandoned.

M.P.E.P. § 1214.06 states that an application is abandoned two months after a decision of the Board. Thus, on Feb. 11, 2005 the present application was abandoned following the Dec. 10, 2004 decision of the Board. The present petition was not filed on July 15, 2005, which was more than five months past the date of abandonment. This application remains abandoned for failure to take further action within two months from the decision of the Board.

Accordingly, the petition to reopen prosecution and withdraw abandonment is dismissed.

In order to reopen prosecution, the petitioner must first petition to withdraw abandonment under 37 C.F.R. 1.137 and include the applicable fee. At that point, the petitioner is invited to file the Request for Continued Examination with the amendment of claims 1-12.

Petitioner may file a request for reconsideration of this decision, without fee. However, such a request must be filed within two months of the date of this decision. Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.



Karen M. Young, Director
Technology Center 3700